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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/766,219 | 01/28/2004 | Michael W. Stephens | STEPHENS 1 | 2889 |

31704 7590 10/21/2005

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| EXAMINER |
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TOOMER, CEPHIA D

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| ART UNIT | PAPER NUMBER |
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1714

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,219

Applicant(s)

STEPHENS, MICHAEL W.

Examiner

Cephia D. Toomer

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-28,30,35 and 36 is/are rejected.
- 7) ☐ Claim(s) 29,31-34,37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the amendment filed August 2, 2005 in which claims 1-25 were canceled and claim 26 was amended.

All rejections involving claims 1-25 are withdrawn in view of the cancellation of claims 1-25.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 26-28, 30 and 36 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 03/080770 for the reasons of record.

3. Applicant's arguments filed have been fully considered but they are not persuasive.

Applicant argues that there is no disclosure in WO of both a package and a combustible material inside the package. Applicant argues that WO contains no reference of any packaging at all but only a disclosure of a ventilated, flammable structure wherein there is no combustible material placed within the package.

The conical ventilated structure is a package because it contains the combustible burner (3). Webster's Dictionary defines a package as a container in which something

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is packed or a preassembled unit. The structure of WO clearly meets the definition of a package.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03/080770.

Applicant argues that WO contains no teaching with respect to the size limitations and that the size of the instant package is designed for purpose of use in a home grill.

The examiner respectfully disagrees and maintains that it would have been obvious to optimize the size of the combustible package especially in view of WO teaching the same intended use, i.e., use in barbecue grill. Furthermore, a change in size is generally recognized as being within the level of ordinary skill in the art and changing the size of the package is not sufficient to patentably distinguish over the prior art. *In re Rose*, 105 USPQ 237 (CCPA 1955); MPEP 2144.04 IV.

6. Applicant argues that the declaration of Michael W. Stephens is insufficient to overcome the prior art because of Mr. Stephen's alleged commercial success.

The examiner respectfully disagrees. Applicant's product that is being sold is not commensurate in scope with the claims. Applicant has not established a nexus between the claimed invention and the commercial success because there is no

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evidence that the product which has been sold corresponds to the claimed invention, or that whatever alleged commercial success may have occurred is attributable to the product defined by the claims. Ex parte Standish, 10 USPQ2d 1454 (BPAI 1988).

Applicant's sales figures must be adequately defined. CharCone product selling better than 2 to 1 and sales averaging over 60 % or 25 % of the market share does not tell how many products were sold, what sales would normally be expected in the market or during what time period was the product sold (4 weeks in the winter, summer, spring, fall ?). These figures may be attributable to any number of factors not associated with the product.

7. Claims 29, 31-34 and 37 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cephia D. Toomer
Primary Examiner
Art Unit 1714

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